

Attorney Docket No. 21757-0002
Application No. 10/644,402

REMARKS

The present invention is directed to a cover for the rear storage compartment of a pickup truck or similar vehicle having an open top storage compartment, the cover comprised of at least two panels made of a rigid material casing attached to structural members specifically designed to support and transport a significant load placed on top of the cover. A center panel is substantially and removably secured to the top of the sidewalls of the rear storage compartment by attachment means that does not require drilling into any portion of the vehicle. In addition, all the non-substantially secured panels are lockable, and are hingedly and removably attached to the at least one substantially secured panel, providing secure and easy access to the rear storage compartment. The hinge attachment further allows for each non-substantially secured panel to be removed individually, providing alternative panel configurations for carrying large items. All panels work in conjunction with locking rods and water sealant devices to provide a substantially water resistant and secure cover.

Remarks Concerning the Claims

Claims 1-15 and 21-25 are pending in the subject application, with claims 21-25 newly added. Claim 16 is canceled by this amendment, and claims 17-20 were previously canceled by verbal amendment during a telephone interview between the undersigned and the Examiner.

This amendment is provided in response to the Office Action dated August 2, 2004. In that action, the Examiner withdrew claim 16 from consideration as a being drawn to a non-elected species. The Examiner rejected claims 1-15 under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner particularly stated that "Regarding claims 1-15, 'the cover of sufficient strength to support a significant top load' fails to particularly point out and distinctly claim the subject matter which applicant regards as the invention." Applicant submits that the Examiner's rejection under 35 U.S.C. § 112 is clearly erroneous. Applicant took great

Attorney Docket No. 21757-0002
Application No. 10/644,402

care to define the meaning of "the cover of sufficient strength to support a significant top load" in the specification to support the use of that defined term in independent claim 1. In particular, applicant defined the term in the specification at paragraph [0009] as follows: "For purposes of this application, "significant load" is defined as exceeding 220 pounds, up to the rated limit of the pickup truck or vehicle." If Applicant is diligent in carefully defining terms used in its claims, the least the Examiner can do is to carefully read the specification. In this case, carefully reading paragraph [0009] would have obviated the need for the Examiner's rejection, and certainly renders it inappropriate. For these reasons, Applicant requests that the Examiner remove the rejection under 15 U.S.C. §112, second paragraph.

The Examiner rejected claims 1-9 and 12-13 as being anticipated under 35 U.S.C. § 102(b) by U.S. Patent 6,082,806 to Bogard (hereinafter "Bogard"). In particular, the Examiner stated:

Bogard discloses in Fig.1-16 the invention as claimed to include a cover 20, two panels 26,27, aluminum thin rigid casing 28 (col 2, lines 65-66), a plurality of horizontal structural members 29, bedrails 24, a storage compartment 21, one panel secured to the bedrail (Fig. 13), a hinge 42, locking means (col 3 line 61 to col 4 line 5).

Applicants respectfully traversc the rejection of claims 1-9 and 12-13 under 35 U.S.C. 102(b). Bogard, as understood, is directed to a kit for making a tonneau cover that can be assembled by a consumer. Bogard teaches a kit that can be adapted to produce tonneau covers of differing sizes, and addresses the manufacturing need for such flexible fitting of covers. One or more of the features recited by Applicant in independent claims 1-9 and 12-13 are not taught or suggested by Bauer.

First, Bogard does not motivate, teach, or suggest the claimed top load capability of a tonneau cover. Bogard as cited by the Examiner fails to meet the defined requirement of claim 1 that the "cover is of sufficient strength to support a significant top load." As previously discussed, significant top load is a defined term per paragraph [0009] of the specification, and nothing in Bogard teaches or suggests that the Bogard cover could withstand a significant top load. Indeed, the teachings of Bogard being directed to a cover that can be sized, fabricated and

Attorney Docket No. 21757-0002
Application No. 10/644,402

assembled by a consumer user teach away from the use of materials that could be cut and combined to support a significant top load as taught and claimed by Applicant.

Moreover, Applicant's claims are directed to a cover having at least three panels wherein the panels are hingedly attached, but removeably detachable, from each other. Bogard teaches that the two panels are fastened together permanently with a bolted-on bracket as shown in Fig. 9A.

With respect to the dependent claims 2-15, additional limitations are added that are not anticipated by Bogard, and that underscore the fact that Bogard's teachings do not product a cover that can withstand as significant top load. Notably, Applicant's panels are designed to lock under the bed rails of the truck without any bracketing or drilling into the truck bedrails, while Bogard's panels are bolted to the bedrails as shown in Fig. 9A. Additionally, as claimed in claims 14-15 and 21-25, Applicant's locking means include locking rods that are adjustable to fit under the bedrails or into factory created holes in the bed rails in order to lock our cover directly to the bedrails of the truck and not to any external component. In contrast, Bogard Fig. 12 teaches and requires a small bracket be mounted on the bedrail to receive a locking rod. Bogard's use of a small bolt-on bracket for this purpose also underscores the fact that Bogard again did not anticipate a significant top load because the locking road and bracket arrangement of Fig. 12 would not withstand the forces placed on it by a shifting significant top load.

Lastly, without conceding any of the above arguments, Applicant has amended claim 1 to recite a more particular cover configuration, including at least 3 panels having particular arrangement and connectivity, that is not anticipated by the two-panel cover taught by Bogard. Applicant believes that the amendments to claim 1 hereunder make the Examiner's rejection of claims 1-9 and 12-13 under Section 102(b) moot.

Thus, since Bogard does not teach or suggest all of the limitations recited in independent claim 1, Applicant respectfully submits that Bogard does not anticipate Applicant's invention as recited in independent claims 1-9 and 12-13.

The Examiner has rejected claims 10-11 under 35 U.S.C. §103(a) as being unpatentable over Bogard in view of U.S. Patent 6,234,559 to Block et al ("Block"). The following principle of law applies to all Section 103 rejections. MPEP 2143.03 provides, "To establish prima facie obviousness of a claimed invention, all claim

Attorney Docket No. 21757-0002
Application No. 10/644,402

limitations must be taught or suggested by the prior art. In re Royka, 490 F2d 981, 180 USPQ 580 (CCPA 1974). All words in a claim must be considered in judging the patentability of that claim against the prior art. In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970)." [Emphasis added.] That is, to have any expectation of rejecting the claims over a single reference or a combination of references, each limitation must be taught somewhere in the applied prior art. If limitations are not found in any of the applied prior art, the rejection cannot stand.

Applicant submits that the amendments to the claims, and particularly to independent claim 1, from which claims 10-11 depend, makes moot the rejection of claims 10-11 under 35 U.S.C. §103(a) over Bogard in view of Block. Specifically, neither of those references teach or suggest a three-panel tonneau cover having the particular arrangement and attachment claimed by Applicant, and none teach a cover that can support a significant top load as claims and as previously described herein. Accordingly, the Examiner's rejection of claims 10-11, which add a gutter limitation to claim 1, is moot. Applicant requests withdrawal of the rejection under 35 U.S.C. § 103, and consideration and allowance of claims 10-11.

The Examiner further rejected claims 14-15 under 35 U.S.C. §103(a) as being unpatentable over Bogard in view of U.S. Patent 6,616,210 to Massey ("Massey"). For the above reasons set forth with respect to amended claim 1, Applicant submits that the amendments to claim 1 makes moot the rejection of claims 14-15 under 35 U.S.C. §103(a) over Bogard in view of Massey. Accordingly, the Examiner's rejection of claims 14-15, which add a support means limitation to claim 1, is moot. Applicant requests withdrawal of the rejection under 35 U.S.C. § 103, and consideration and allowance of claims 14-15.

Applicant has amended the claims and added new claims, and submits that no new matter results from the amendments. No new matter is presented by this amendment.

Attorney Docket No. 21757-0002
Application No. 10/644,402

CONCLUSION

In view of the above, Applicant respectfully requests entry of this amendment, reconsideration of the Application and withdrawal of the outstanding rejections. As a result of the amendments and remarks presented herein, Applicant respectfully submits that claim 1, as amended, is neither anticipated by the cited prior art nor rendered obvious, nor are claims 2-15, or new claims 21-25 rendered obvious by the cited art.

As the claims are not anticipated by nor rendered obvious in view of the applied art, Applicant requests withdrawal of the outstanding rejections and allowance of claims 1-15 and 21-25. If the Examiner believes that prosecution of this Application could be expedited by a telephone conference, the Examiner is encouraged to contact applicant's attorney at the phone number listed below.

The Commissioner is hereby authorized to charge any additional fees and credit any overpayments to Deposit Account No. 50-1059.

Respectfully submitted,

MCNEES WALLACE & NURICK LLC

By



Kurt L. Ehresman
Reg. No. 50,758
100 Pine Street
P.O. Box 1166
Harrisburg, PA 17108-1166
Tel: (717) 237-5458
Fax: (717) 237-5300
Attorney for Applicant

Dated: November 2, 2004

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

PTO/SB/07 (08-03)

Approved for use through 07/31/2006. OMB 0651-0031
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

Certificate of Transmission under 37 CFR 1.8

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office

on November 2, 2004.

Date


Signature

Patricia L. Ballantyne

Typed or printed name of person signing Certificate

Note: Each paper must have its own certificate of transmission, or this certificate must identify each submitted paper.

Transmittal Form
Response Under 37 C.F.R. 1.111

Attorney Docket No.: 21757-0002

This collection of information is required by 37 CFR 1.8. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 1.8 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.